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SERIAL NUMBER	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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08/196,812 02/02/94 NILSEN

B5M1/1222

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CAESAR DRIVE
BARRINGTON, IL 60010

EXAMINER

MIS, D

ART UNIT PAPER NUMBER

24

2502
DATE MAILED:

12/22/94

This is a communication from the examiner in charge of your application.
COMMISSIONER OF PATENTS AND TRADEMARKS

☒ This application has been examined ☒ Responsive to communication filed on 12/13/94 ☒ This action is made final.

A shortened statutory period for response to this action is set to expire 3 month(s), 0 days from the date of this letter.
Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133

Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

- | | |
|---|---|
| 1. <input type="checkbox"/> Notice of References Cited by Examiner, PTO-892. | 2. <input type="checkbox"/> Notice of Draftsman's Patent Drawing Review, PTO-948. |
| 3. <input type="checkbox"/> Notice of Art Cited by Applicant, PTO-1449. | 4. <input type="checkbox"/> Notice of Informal Patent Application, PTO-152. |
| 5. <input type="checkbox"/> Information on How to Effect Drawing Changes, PTO-1474. | 6. <input type="checkbox"/> |

Part II SUMMARY OF ACTION

1. ☒ Claims 52-76, 80-100 are pending in the application.
Of the above, claims _____ are withdrawn from consideration.
2. ☒ Claims 1-51, 77-79 have been cancelled.
3. ☐ Claims _____ are allowed.
4. ☒ Claims 52-76, 80-100 are rejected.
5. ☐ Claims _____ are objected to.
6. ☐ Claims _____ are subject to restriction or election requirement.
7. ☐ This application has been filed with informal drawings under 37 C.F.R. 1.85 which are acceptable for examination purposes.
8. ☐ Formal drawings are required in response to this Office action.
9. ☐ The corrected or substitute drawings have been received on _____. Under 37 C.F.R. 1.84 these drawings are ☐ acceptable; ☐ not acceptable (see explanation or Notice of Draftsman's Patent Drawing Review, PTO-948).
10. ☐ The proposed additional or substitute sheet(s) of drawings, filed on _____, has (have) been ☐ approved by the examiner; ☐ disapproved by the examiner (see explanation).
11. ☐ The proposed drawing correction, filed _____, has been ☐ approved; ☐ disapproved (see explanation).
12. ☐ Acknowledgement is made of the claim for priority under 35 U.S.C. 119. The certified copy has ☐ been received ☐ not been received ☐ been filed in parent application, serial no. _____; filed on _____.
13. ☐ Since this application appears to be in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213.
14. ☐ Other

EXAMINER'S ACTION

1. Claims 67-71 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 67, second-last line, "one of the second pair of terminals" evidently refers to the "second pair of terminals" of the same claim, fifth-last line. Applicant has pointed this out in paper 23, on page 3, lines 1-23 in his "Remarks".

Applicant has also pointed out, over the phone, while explaining the construing process of paper 19, that he finds use in demonstrating to a customer that one can place one probe of an oscilloscope on, for example, a junction (Ja or Jb) and place the other oscilloscope probe somewhere else in his ballast means and see the "substantially sinusoidal voltage of frequency several times higher than that of the AC power line voltage".

Claim 67 points out that the junction (Ja or Jb) and another terminal of the ballast (Ja or Jb and the another terminal constituting the "second pair of terminals") is what covers the location of the "substantially sinusoidal AC voltage". Looking at this a little closer, it is seen that the location of the "substantially sinusoidal AC voltage" might then be for example from a junction (Ja or Jb) to ***the other of (Ja or Jb)** or from a junction (Ja or Jb) to one of the DC input terminals, or to the like. Therefore the function "... substantially sinusoidal voltage ..." is performed by the respective set of ballast elements between the junction (Ja or Jb) and the one of the other terminals of the ballast where a respective AC voltage exists that one reading the claim might construe. In effect, it is not known what might cover the claimed function any more than it is known what the reader of the claim will construe. This is regarded as indefiniteness since different non equivalent means are claimed all by the same language. Separate claims for each of the known possible locations of an AC voltage are necessary.

(***"the other ..."** - see paper 22 (Office Action of 9/19/94), page 2, third to second-last lines, "the other of Ja or Jb" were meant to refer to the same problem as noted above in more detail.)

In claim 67, last two lines, "the first transistor terminal" should have been --said first transistor terminal-- since "the first transistor terminal" could be for example a first one of the three belonging to the second transistor, etc.

2. It is noted that in claim 52, both the voltage across 1/2 of L and across PW1/PW2 are called "very small" with respect to the inverter AC output voltage, while one is half of the inverter AC output voltage of hundreds of volts and the other is around .2

volts, which is true in both cases but does not mean that they are similar voltages.

3. The obviousness-type double patenting rejection is a judicially established doctrine based upon public policy and is primarily intended to prevent prolongation of the patent term by prohibiting claims in a second patent not patentably distinct from claims in a first patent. *In re Vogel*, 164 USPQ 619 (CCPA 1970). A timely filed terminal disclaimer in compliance with 37 C.F.R. § 1.321(b) would overcome an actual or provisional rejection on this ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 C.F.R. § 1.78(d).

4. Claims 1-76 and 80-100 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-9 of U.S. Patent No. 4,692,667.

Although the conflicting claims are not identical, they are not patentably distinct from each other because the patented claims are covered by the same means presently claimed.

Regarding Applicant's comments on "Exemplary claim 52", the functional language noted by Applicant covered by 1/2 of the inductor L is obvious in view of means covering the functional language of the patented claims for the inverter output voltage characteristics.

Regarding Applicant's comments on "Exemplary claim 54", the language noted by Applicant covered by the transistors and substantially sinusoidal voltage means is obvious in view of means covering the functional language of the patented claims for the inverter output voltage characteristics.

Regarding Applicant's comments on "Exemplary claim 59" and "Exemplary claim 65", the language noted by Applicant covered by

IM is obvious in view of means covering the functional language of the patented claims for the connection of the inverter to the DC output terminals.

That is, the ballast means were construed to cover what was patented in '667. Now, any means covering any currently claimed function, having already been patented by virtue of their covering the functions of the patented claims, can not be non-obvious. Applicant is only at liberty to, in effect, put his claims for those means in yet another set of ways, not to re-patent those means.

5. Applicant further points out, paper 23, page 4, lines 4-23, that the filter elements 31-33 of Burke are not sized to provide a "substantially constant-magnitude DC supply voltage", so Burke did not anticipate the claimed invention. This is true.

6. The prior art of record did not anticipate, at least:

Claim 52- having the AC voltage across an output terminal and DC supply terminal.

Claim 54- same as 52.

Claim 59- having a rectifying/filtering means supply a substantially constant magnitude DC supply voltage to an inductor means having first and second windings.

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Claim 65- having a rectifying/filtering means construed to supply a substantially constant magnitude DC supply voltage to an inductor means having first and second windings.

Claim 67- having a rectifying/filtering means supplying a DC supply voltage of absolute magnitude distinctly higher than an absolute magnitude of an AC supply voltage to an inverter producing a substantially sinusoidal AC voltage. (The "motivation" to have done this before not being in the references.)

Claim 72- same as 59.

Claim 80- same as 59.

Claim 84- similar to 67 with the parallel resonant means corresponding to providing the substantially sinusoidal AC wave.

Claim 90- same as 52.

Claim 92- same as 52.

Claim 93- same as 52.

Claim 96- having auxiliary terminals having with voltage on average equal to the DC voltage of substantially constant magnitude.

Claim 98- similar to 59 with the constant magnitude construed to be substantially constant.

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 C.F.R. § 1.136(a).

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A SHORTENED STATUTORY PERIOD FOR RESPONSE TO THIS FINAL ACTION IS SET TO EXPIRE THREE MONTHS FROM THE DATE OF THIS ACTION. IN THE EVENT A FIRST RESPONSE IS FILED WITHIN TWO MONTHS OF THE MAILING DATE OF THIS FINAL ACTION AND THE ADVISORY ACTION IS NOT MAILED UNTIL AFTER THE END OF THE THREE-MONTH SHORTENED STATUTORY PERIOD, THEN THE SHORTENED STATUTORY PERIOD WILL EXPIRE ON THE DATE THE ADVISORY ACTION IS MAILED, AND ANY EXTENSION FEE PURSUANT TO 37 C.F.R. § 1.136(a) WILL BE CALCULATED FROM THE MAILING DATE OF THE ADVISORY ACTION. IN NO EVENT WILL THE STATUTORY PERIOD FOR RESPONSE EXPIRE LATER THAN SIX MONTHS FROM THE DATE OF THIS FINAL ACTION.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to David Mis whose telephone number is (703) 308-4907.



DAVID MIS
EXAMINER
GROUP ART UNIT 252

dm
December 21, 1994